UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,733	06/12/2000	CHARLES ZUKER	02307E-085110US	6739

7590 08/04/2008

ANNETTE S PARENT
TOWNSEND AND TOWSEND AND CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111

EXAMINER	
MYERS, CARLA J	
ART UNIT	**PAPER NUMBER**
1634	

MAIL DATE	DELIVERY MODE
08/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ATTACHMENT TO ADVISORY:

Continuation of Box 3:

The proposed amendments filed after final rejection will not be entered because the amendments change the scope of the claims and raise new issues that would require further search and consideration. The claims have been amended to recite a method in which the level of RDGC GPCR phosphatase activity is detected in a first and second sample, wherein first and second sample are contacted with a test compound, and the level of RDGC GPCR phosphatase activity is detected in the first and second samples contacted with a test compound, to thereby detect modulators of RDGC GPCR phosphatase. The specification as originally filed does not provide basis for such an amendment. Further, the claims previously required only contacting a first sample with a test compound. The amendment to require determining the RDGC GPCR phosphatase activity in the second sample and contacting the second sample with a test compound and determining the level of RDGC GPCR phosphatase activity in the treated second sample alters the scope of the claims and raises new issues that require further consideration. This amendment also raises new issues under 35 USC 112 second paragraph in that it is unclear as to the relevance of detecting the change in level of RDGC GPCR phosphatase activity in the second sample. The claim as amended recites a final step of detecting RDGC phosphatase activity in the first and second samples, but does not state whether this step is the same as step (iii) or if this step is performed using the first and second samples contacted with a test compound. Further, the claims do not set forth how detecting RDGC GPCR phosphatase activity in the first

and second samples results in the determination that a test compound is a modulator of RDGC GPCR phosphatase activity.

Continuation of Box 11:

The request for reconsideration has been considered but does not place the application in condition for allowance for the reasons of record in view of the non-entry of the after final amendment. To the extent that the response addresses the claims as amended, these arguments are not persuasive in view of the non-entry of the after final amendment. To the extent that the response addresses the claims as filed in the response of February 28, 2008, these arguments have been fully considered but are not persuasive. Applicants state that the specification as originally filed provides basis for the claimed invention. Applicants assert that the inventors used mutant rhodopsin as a control in Example 1. However, Example 1 of the specification does not state that mutant rhodopsin is being used as a control. Rather, Example 1 indicates only that wildtype and rdgC mutant phosporeceptor neurons were examined. Thereby, Applicant's statement does not accurately characterize the teachings in Example 1 of the specification. The response further states that given the teachings of Example 1, the skilled artisan would be familiar with the concept of controls and would understand that a screening method would employ a control. However, as noted by Applicants, Example 1 is not a screening method and does not include a step of contacting the claimed first and second samples with a test compound and determining RDGC GPCR phosphatase activity in first and second samples to determine if a test compound is a modulator of RDGC GPCR phosphatase activity. Thereby, the teachings in Example 1 cannot be

relied upon to establish possession of the concept of using a control in a method of testing for modulators of RDGC GPCR phosphatase activity. Applicants conclude that because control samples are known in the art, one would understand that a control would be used in a screening method, and that such a control sample with Rh1delta356 would be an appropriate comparison in assays for RDGC GPCR phosphatase activity. This argument has also been fully considered but is not persuasive because the rejection under 35 USC 112 first paragraph (new matter) is not based on the obviousness of including a control, such as the Rh1Δ356 mutant, in a screening method, but is based on the finding that the originally filed specification did not provide basis for such a concept. The fact that controls were known in the art at the time the invention was made does not overcome the issue that the specification as originally filed does not provide support for this limitation. Obviousness is not the standard for the addition of new limitations to the disclosure as filed. Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. Lockwood v. American Airlines Inc., 41 USPQ2d 1961 (Fed. Cir. 1977). Further, even if the specification did disclose the concept of using controls (which it does not), the specification does not provide support for the specific concept of using the Rh1Δ356 mutant as a control in an assay to screen for modulators of RDGC GPCR phosphatase activity. Additionally, the rejection is maintained because the claims encompass the use of mutants in which more than 18 amino acids are deleted from the COOH terminus, whereas the specification as originally filed provides basis only for the concept of the Rh1Δ356 mutant in which only the COOH-terminal 18 amino acids are

deleted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is 571-272-0747. The examiner can normally be reached on Monday-Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carla Myers/
Primary Examiner, Art Unit 1634